UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,254	04/09/2001	James Y. Liu	005580.P001	9476

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ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/832,254	LIU ET AL.
	Examiner	Art Unit	
	Ashok B. Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 December 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-58</u> is/are pending in the application.

    4a) Of the above claim(s) <u>44-58</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-43</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. Application Number 09/832, 254 was filed on 04/09/2001. Claims 1-58 are

subject to examination. Claims 1-43 are cancelled.

Response to Arguments

2. Applicant's arguments with respect to claim 1, 12, 20, 28 and 38 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-14, 16-22 and 24-27 are rejected under 35 U.S.C. 102(e) as being

anticipated Hypponen et al. (hereinafter Hypponen)(US 2003/0191957 A1).

Referring to claim 1,

The reference teaches a system, comprising:

a recipient's email gateway connected to a network and configured to receive

email messages from the network; (Fig. 1, element 4b) and

a group of email-scanning servers comprising one or more email scanning

servers, each of the email-scanning servers configured with anti-virus software to scan

and clean viruses, the group of email-scanning servers connected to the network,

(Fig.1, element 7, page 1, para.[0020]," [0020] In certain embodiments of the invention,

the network may be provided with only a single virus scanning server which serves one

or more transit nodes. In other embodiments however, the network may comprise a

plurality of servers.")

wherein when the recipient's email gateway receives an email message from the

network, the email message is transmitted to the group of email-scanning servers over

the network to generate a clean email message using the anti-virus software, and

wherein the clean email message is transmitted by the group of email-scanning

servers to the recipient's email gateway. (Figs. 1 and 2, page 2, para.[0034]," The

server 7 is able to communicate with the protected systems 4 and workstation 2a using

for example proprietary and standardized protocols carried over the TCP/IP network

3.")

Referring to claim 2,

The reference teaches the system of claim 1, wherein the email message is transmitted

from the recipient's email gateway to the group of email-scanning servers after the email

message is verified to determine if the email message needs to be scanned and

cleaned. (Fig.2, page 2, para.[0034])

Referring to claim 3,

The reference teaches the system of claim 2, wherein the email message is verified by

determining source of the email message, wherein when the source of the email

message is the group of the email-scanning servers, the email message has already

been scanned and cleaned. (Fig.2, page 2, para.[0036])

Referring to claim 5,

The reference teaches the system of claim 1 , wherein the email message is transmitted from the recipient's email gateway to the group of email-scanning servers using a pre-configured IP address of the group of email-scanning servers or using a DNS server connected to the network to determine an IP address of the group of email-scanning servers. (page 2, para.[0034])

Referring to claims 6 and 7,

The reference teaches the system of claim 1, wherein the group of email-scanning servers includes incoming email processing logic to receive the email message to be scanned and cleaned and outgoing email processing logic to transmit the clean email message and , wherein the group of email-scanning servers further includes subscriber verification processing logic to determine if the email message belongs to a recipient who is a subscriber to an email scanning and cleaning service performed by the group of email-scanning servers. (Fig.2)

Referring to claim 8,

The reference teaches the system of claim 1 , wherein each email-scanning server in the group of email-scanning servers comprises one or more anti-virus software.(page 2, para.[0036])

Referring to claim 9,

The reference teaches the system of claim 1, wherein the recipient's email gateway includes email server processing logic. (Fig.1, element 4b)

Referring to claim 10,

The reference teaches the system of claim 1, further comprising a recipient's email server coupled with the recipient's email gateway and connected to the network, wherein after the recipient's email gateway receives the clean email messages from the group of email-scanning servers, the recipient's email gateway transmits the clean email messages to the recipient's email server. (Fig. 1, Fig.2, page 2, para.[0037])

Referring to claim 11,

The reference teaches the system of claim 1, wherein the recipient's email gateway is further configured to receive the email messages from a service provider's email server. (Fig. 1, element 5, "Mail Server 4b in Fig. 1 is connected to Internet 5, thereby it is inherently configured to receive the emails from a service provider's email server.)

Referring to claim 12,

Claim 12 is a claim to method steps that are carried out by the system of claim 1. Therefore claim 12 is rejected for the reasons set forth for claim 1.

Referring to claim 13,

Claim 13 is a claim to method steps that are carried out by the system of claim 2. Therefore claim 13 is rejected for the reasons set forth for claim 2.

Referring to claim 14,

Claim 14 is a claim to method steps that are carried out by the system of claim 3. Therefore claim 14 is rejected for the reasons set forth for claim 3.

Referring to claim 16,

Claim 16 is a claim to method steps that are carried out by the system of claim 5. Therefore claim 16 is rejected for the reasons set forth for claim 5.

Referring to claim 17,

Claim 17 is a claim to method steps that are carried out by the system of claims 6 and

7. Therefore claim 17 is rejected for the reasons set forth for claims 6 and 7.

Referring to claim 18,

Claim 18 is a claim to method steps that are carried out by the system of claim 10.

Therefore claim 18 is rejected for the reasons set forth for claim 10.

Referring to claim 19,

Claim 19 is a claim to method steps that are carried out by the system of claim 11.

Therefore claim 19 is rejected for the reasons set forth for claim 11.

Referring to claim 20,

Claim 20 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 12. Therefore claim 20 is rejected for the

reasons set forth for claim 12.

Referring to claim 21,

Claim 21 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 13. Therefore claim 21 is rejected for the

reasons set forth for claim 13.

Referring to claim 22,

Claim 22 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 14. Therefore claim 22 is rejected for the

reasons set forth for claim 14.

Referring to claim 24,

Claim 24 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 16. Therefore claim 24 is rejected for the

reasons set forth for claim 16.

Referring to claim 25,

Claim 25 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 17. Therefore claim 25 is rejected for the

reasons set forth for claim 17.

Referring to claim 26,

Claim 26 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 18. Therefore claim 26 is rejected for the

reasons set forth for claim 18.

Referring to claim 27,

Claim 27 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 19. Therefore claim 27 is rejected for the

reasons set forth for claim 19.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
>
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
>
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
>
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
>
> negatived by the manner in which the invention was made.

6.   Claims 4, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hypponen et al. (hereinafter Hypponen)(US 2003/0191957 A1) in view of Kim et al.

(hereinafter Kim)(US 5, 701, 440)

Referring to claim 4,

Keeping in mind the teachings of the reference Hypponen as stated above, the

reference fails to explicitly teach wherein the email message is verified by checking a

status code in a header of the email message, and the status code is updated.

The reference kim teaches these limitations in col. 6, lines 16-47.

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of invention was made to Incorporate the teachings of Kim in system of

Hypponen such that the cleaned message is identified by the user. It would have been

obvious because it allows a user setting that the desired subject line of the e-mail

message forwarded to the forwarding e-mail address. The desired subject line of the

forwarded e-mail message may be different for clean e-mail messages and for

previously infected and cleaned e-mail messages so as to identify that the e-mail

message had to be cleaned of virus(es) as taught by Kim.

Referring to claim 15,

Claim 15 is a claim to method steps that are carried out by the system of claim 4.

Therefore claim 15 is rejected for the reasons set forth for claim 4.

Referring to claim 23,

Claim 23 is a claim to a computer readable medium containing executable instructions

which, when executed in a processing system, causes the processing system to

perform the steps of a method of claim 15. Therefore claim 23 is rejected for the

reasons set forth for claim 15.

7.   Claims 28—30, 32-40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hypponen et al. (hereinafter Hypponen)(US 2003/0191957 A1) in

view of Kulakowski (US 2004/0100648 A1)

Referring to claim 28,

The reference Hypponen teaches the system, comprising:

        a service provider's email server connected to a network and configured

to receive email messages from the network; (Fig. 1, element 5, "Mail Server 4b in Fig.

1 is connected to Internet 5, thereby it is inherently configured to receive the emails

from a service provider's email server.)

        a recipient's email gateway coupled with the service provider's email server and

connected to the network the recipient's email gateway (Fig. 1, element 5, "Mail Server

4b in Fig. 1 is connected to Internet 5, thereby it is inherently configured to receive the

emails from a service provider's email server.)

a group of email-scanning servers comprising one or more email scanning

servers, each of the email-scanning servers includes anti-virus software to scan and

clean viruses, the group of email-scanning servers connected to the network (Fig.1,

element 7, page 1, para.[0020]," [0020] In certain embodiments of the invention, the

network may be provided with only a single virus scanning server which serves one or

more transit nodes. In other embodiments however, the network may comprise a

plurality of servers.");

wherein when the recipient's email gateway retrieves the email messages from

the service provider's email server, the email messages are transmitted to the group of

email-scanning servers over the network to generate clean email messages. (Fig. 1,

element 5, (Figs. 1 and 2, page 2, para.[0034]," The server 7 is able to communicate

with the protected systems 4 and workstation 2a using for example proprietary and

standardized protocols carried over the TCP/IP network 3.")

However, the reference Hypponen fails to teach recipient's email gateway

configured to retrieve the email messages from the service provider's email server at

predetermined time periods.

The reference Kulakowski teaches at page 7, para.[0061], "Alternatively to the

above-described method by which fax interface 26 polls service provider 32 to

determine whether email messages have been received, service provider 32 may

automatically and immediately send any email message it receives. Service provider 32

may forward the email message immediately upon receiving it, periodically, or at a

predetermined time. FIG. 8 illustrates a method that interface device 26, under the

control of processor 33, performs for receiving conventional faxes and email messages,

the latter either from service provider 32 or from another device of the present

invention." (Thus the reference teaches the interface retrieving the email messages at a

predetermined time.)

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of invention was made to Incorporate the Kulakowski's interface in the mail

server of Hypponen such that retrieving of e-mail messages based upon time criteria.

It would have obvious because it provides the ability to poll the service provider wherein

service provider can forward the email messages in various ways such as immediately

upon receiving it, periodically, or at a predetermined time as taught by Kulakowski.

Referring to claim 29,

The reference Hypponen teaches a system of claim 28, wherein the clean email

messages are transmitted by the group of email-scanning servers to the recipient's

email gateway or to the service provider's email server. (Fig. 2)

Referring to claim 30,

The reference Hypponen teaches the system of claim 28, wherein the email message is

transmitted from the recipient's email gateway to the group of email-scanning servers

after the email message is verified to determine if the email message needs to be

scanned and cleaned. (Fig.2, page 2, para.[0034])

Referring to claim 32,

The reference Hypponen teaches the system of claim 28 , wherein the email message

is transmitted from the recipient's email gateway to the group of email-scanning servers

using a pre-configured IP address of the group of email-scanning servers or using a

DNS server connected to the network to determine an IP address of the group of email-

scanning servers. (page 2, para.[0034])

Referring to claims 33 and 34,

The reference Hypponen teaches the system of claim 28, wherein the group of email-

scanning servers includes incoming email processing logic to receive the email

message to be scanned and cleaned and outgoing email processing logic to transmit

the clean email message and , wherein the group of email-scanning servers further

includes subscriber verification processing logic to determine if the email message

belongs to a recipient who is a subscriber to an email scanning and cleaning service

performed by the group of email-scanning servers. (Fig.2)

Referring to claim 35,

The reference Hypponen teaches the system of claim 28 , wherein each email-scanning

server in the group of email-scanning servers comprises one or more anti-virus

software.(page 2, para.[0036])

Referring to claim 36,

The reference Hypponen teaches the system of claim 28, wherein the recipient's email

gateway includes email server processing logic. (Fig.1, element 4b)

Referring to claim 37,

The reference Hypponen teaches the system of claim 1, further comprising a recipient's

email server coupled with the recipient's email gateway and connected to the network,

wherein after the recipient's email gateway receives the clean email messages from the

group of email-scanning servers, the recipient's email gateway transmits the clean email

messages to the recipient's email server. (Fig. 1, Fig.2, page 2, para.[0037])

Referring to claim 38,

Claim 38 is a claim to method steps that are carried out by the system of claim 28.

Therefore claim 38 is rejected for the reasons set forth for claim 28.

Referring to claim 39,

Claim 39 is a claim to method steps that are carried out by the system of claim 30.

Therefore claim 39 is rejected for the reasons set forth for claim 30.

Referring to claim 40,

The reference Hypponen teaches the method of claim 39, wherein verifying comprises

checking source of the incoming email messages, and wherein when the source of the

incoming email messages is the group of email-scanning servers, the incoming email

messages are clean. (Fig.2, page 2, para.[0036])

Referring to claim 42,

Claim 42 is a claim to method steps that are carried out by the system of claim 32.

Therefore claim 42 is rejected for the reasons set forth for claim 32.

Referring to claim 43,

Claim 43 is a claim to method steps that are carried out by the system of claim 34.

Therefore claim 43 is rejected for the reasons set forth for claim 34.

8.   Claims 31 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hypponen et al. (hereinafter Hypponen)(US 2003/0191957 A1) in view of

Kulakowski (US 2004/0100648 A1) as applied to claim 28 above, and further in view of

Kim et al. (hereinafter Kim)(US 5, 701, 440)

Referring to claim 31,

Keeping in mine the teachings of the references Hypponen and Kulakowski as indicated

in claim 28, both of these reference fail to teach wherein the email message is verified

by checking a status code in a header of the email message, and the status code is

updated.

The reference kim teaches these limitations in col. 6, lines 16-47.

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of invention was made to Incorporate the teachings of Kim in the system of

Hypponen along with the Kulakowski's interface such that the cleaned message is

identified by the user. It would have been obvious because it allows a user setting that

the desired subject line of the e-mail message forwarded to the forwarding e-mail

address. The desired subject line of the forwarded e-mail message may be different for

clean e-mail messages and for previously infected and cleaned e-mail messages so as

to identify that the e-mail message had to be cleaned of virus (es) as taught by Kim.

Referring to claim 41,

Claim 41 is a claim to method steps that are carried out by the system of claim 31.

Therefore claim 41 is rejected for the reasons set forth for claim 31.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing responses,

to fully consider the references in entirety as potentially teaching all or part of the

claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-

3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp
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